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09/611,548

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EXAMINER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 09/611,548 | Applicant(s) LOWENSTEIN ET AL. | |
| | Examiner NARAYANSWAMY SUBRAMANIAN | Art Unit 3695 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-205 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-205 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication of November 13, 2010. Amendments to the claims in the applicant's communication and addition of new claims 182-205 have been entered. Claims 1-205 are pending and have been examined. The objections to the drawings, objections to the specification, rejections and response to arguments are stated below.

Drawings

2. The drawings submitted with this application on July 7, 2000 are objected to by the examiner. This application has been filed with informal drawings. For the Applicant's response to be complete, formal replacement drawings for figures 2A-5E are required by the Applicants in their reply to this office action.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

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4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (.Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1 and 2 recite the limitations “a true lease under tax accounting rules” and “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphases added).

Claims 28, 35, 57, 95, 114, 120, 122, 143, 170, 175 and 198 recite the limitation “a true lease under tax accounting rules” (emphasis added).

Claim 31 and 102 recites the limitation “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 56 recites the limitation “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

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Claim 60 recites the limitations “a true lease under tax accounting rules” and “at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer” (emphases added).

Claim 74 recites the limitation “at least some portion of the tenant improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 93 recites the limitation “at least some portion of the lease of the interest being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 119 recites the limitations “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer” and “a primary investor, secondary investor, or lender, who contributed capital to the asset or to an entity owning the asset” (emphases added).

Claim 126 recites the limitation “the portion of the lease performed by processing data in a non-transitory memory of a computer includes formatting or buffering messages for transmission to or received from a potential lessor or lessee on a non-transitory network, or displaying data on a non-transitory display, the data providing a solicitation to enter the improvements lease” (emphasis added).

Claim 127 recites the limitation “the portion of the improvements lease performed by processing data in a non-transitory memory of a computer includes formatting or buffering messages for transmission to or received from a potential lessor or lessee on a non-transitory network, or displaying data on a non-transitory display, or storing data in a non-transitory

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memory, the data containing terms of the improvements lease, the data being transmitted, displayed or stored on a computer of the lessor, lessee, or servicer under control of programs for managing or servicing the improvements lease” (emphasis added).

Claim 128 recites the limitation “the portion of the improvements lease performed by processing data in a non- transitory memory of a computer includes formatting or buffering data for transmission to or received from the lessor, lessee or a servicer over a non-transitory network, or displaying data on a non-transitory display, or storing data in a non- transitory memory, the data containing terms of the improvements lease, the data being transmitted, displayed or stored on a computer of the lessor, lessee, or servicer under control of programs for managing or servicing the improvements lease” (emphasis added).

Claim 129 recites the limitation “the portion of the improvements lease performed by processing data in a non- transitory memory of a computer includes formatting or buffering data for transmission to or received from the lessor, lessee, investor or lender over a non-transitory network, or displaying data on a non-transitory display, or storing data in a non-transitory memory, the data containing terms of the improvements lease, the data being transmitted, displayed or stored on a computer of the lessor, lessee, investor or lender under control of programs for financial analysis of the improvements lease” (emphasis added).

Claim 130 recites the limitation “at least some portion of the tenant improvements lease being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing at least one or more of a group consisting of (a) the landlord, (b) the tenant, a dollar amount of a transaction, and (c) a primary investor, secondary

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investor, or a lender, who contributed capital to the tenant improvements or to an entity owning the tenant improvements (emphases added).

Claim 133 recites the limitations “a true lease under tax accounting rules” and “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer” and “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer, the data representing at least one or more of a group consisting of (a) the landlord, (b) the tenant, and (c) a primary investor, secondary investor, or lender, who contributed capital to the asset or to an entity owning the improvements” (emphases added).

Claim 140 recites the limitation “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing at least one of a group consisting of the landlord, the tenant, a dollar amount of a transaction, and a loan purchaser” (emphasis added).

Claim 148 recites the limitations “a true lease under tax accounting rules” and “at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing at least one of a group consisting of a lessor, the lessee, a dollar amount of a transaction, and a loan purchaser” (emphases added).

Claim 154 recites the limitation “at least some portion of the tenant improvements lease being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing at least one of a group consisting of (a) the landlord, (b) the tenant, (c) a dollar amount of a transaction, and (d) a loan purchaser” (emphasis added).

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Claim 158 recites the limitation “at least some portion of the lease of the interest being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing one or more of a group consisting of the landlord, the tenant, a dollar amount of a transaction and a loan purchaser” (emphasis added).

Claim 161 recites the limitation “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing at least one of a group consisting of the landlord, the tenant, a dollar amount of a transaction and a loan purchaser” (emphasis added).

Claim 172 recites the limitation “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer, data processed by the computer representing at least one of a group consisting of the landlord, the tenant, the special purpose entity, a dollar amount of a transaction and a loan purchaser” (emphasis added).

Claim 179 recites the limitations “classified as an operating lease under financial accounting rules or a true lease under tax accounting rules, and [c] at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 180 recites the limitations “a true lease under tax accounting rules, and at least some portion of soliciting, originating, managing, or analyzing the improvements lease being or having been performed by processing data in a non-transitory memory of a computer” (emphasis added).

Claim 181 recites the limitations “A computer system, comprising: hardware and software designed to assist a tenant in entering an improvements lease, the improvements lease

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to grant the tenant possession and use of improvements to a space leased to the tenant under a space lease that is distinct from the improvements lease; a non-transitory memory storing data providing that the space lease and improvements lease are to be consolidated together as a single lease for financial accounting; and a non-transitory memory storing data providing that, for financial accounting, the consolidated lease is to be treated as an operating lease under financial accounting rules or a true lease under tax accounting rules” (emphasis added).

Claim 182 recites the limitations “One or more non-transitory memories, having stored thereon computer programs and/or data to cause at least one computers to: process a payment on a lease for improvements to a space, financing for the improvements being provided by an entity other than a tenant of the space, financing for the improvements being obtained at the tenant's cost of funds, the space being leased from a landlord to the tenant under a space lease, the improvements lease being distinct from the space lease, at least some portion of the programs and/or data reflecting a characteristic of the improvements lease or the interrelationship between the space and improvements leases” (emphasis added).

Claim 183 recites the limitations “processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease granting rights to use tenant improvements to a tenant, the tenant improvements being improvements to a space leased to the tenant, financing or ownership of the tenant improvements being distinct from financing or ownership of the space, an amount of the payment payable to a tenant improvements payee for lease of the tenant improvements being segregable from an amount payable to a distinct space payee for lease of the space, the segregation reflecting the distinct ownership or financing, the lease of the improvements and the lease of the space lease being structured to

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support an accounting conclusion that the leasing of the space lease and the leasing of the tenant improvements are to be considered together as a single lease and classified as an operating lease under financial accounting rules or a true lease under tax accounting rules; the processed data representing at least one of a group consisting of (a) the lessor of the space, (b) the lessor of the tenant improvements, (c) the tenant, and (d) a primary investor, secondary investor, or lender, who contributed capital to the improvements or to an entity owing the improvements” (emphasis added).

Claim 193 recites the limitations “processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease granting rights to use a shorter-lived asset to a lessee, the shorter-lived asset being functionally related to a longer-lived asset also leased to the lessee, financing or ownership of the shorter-lived asset being distinct from financing or ownership of the longer-lived asset, an amount of the payment payable by the lessee to a payee for the shorter-lived asset for lease of the shorter-lived asset being segregable from an amount payable by the lessee to a distinct payee for lease of the longer-lived asset, the segregation reflecting the distinct ownership or financing, the segregable payment stream directed to the shorter-lived asset having a present value at least equal to a cost of the shorter-lived asset at a time of commencement of the lease covering the shorter-lived asset; at least some portion of the lease to the shorter-lived asset being structured together with the lease to the longer-lived asset to support an accounting conclusion that the two leases are to be considered together as a single lease, classified as an operating lease under financial accounting rules or a true lease under tax accounting rules” (emphasis added).

Claim 197 recites the limitations “processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease granting rights to use tenant improvements to a tenant, the tenant improvements being improvements to a space leased to the tenant, financing or ownership of the tenant improvements being distinct from financing or ownership of the space, an amount of the payment payable to a tenant improvements payee for lease of the tenant improvements being segregable from an amount payable to a distinct space payee for lease of the space, the segregation reflecting the distinct ownership or financing; financing for the tenant improvements being provided by an entity other than a tenant of the space, financing for the tenant improvements being obtained at the tenant's cost of funds; the processed data representing at least one of a group consisting of (a) the lessor of the space, (b) the lessor of the tenant improvements, (c) the tenant, and (d) a primary investor, secondary investor, or lender, who contributed capital to the improvements or to an entity owing the improvements” (emphasis added).

However, the original specification does not provide a written description disclosure to support the claimed limitations identified above especially the emphasized portions of the limitations.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-52 and 56-205 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 2, 28, 31, 56, 60, 74, 93, 102, 119, 130, 133, 140, 148, 154, 158, 161, 172, 181, 182, 183, 193 and 197 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not provide a written description disclosure to support the claimed limitations as discussed in the objections to specification above. Similar reasoning and logic apply to the dependent claims. Dependent claims are also rejected by way of dependency on a rejected independent claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-27, 31-52, and 56-181 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 2, 31, 74, 102, 130, 133, 140, 154, 161, and 179 recite the limitation “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer”. Independent claims 56, 93, 119, 158, and 172 recite the limitation “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer”. Also independent claims 60 and 148 recite the limitation “at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer”. Similarly independent claim 180 recites the limitation “at least some portion of soliciting, originating, managing, or analyzing the improvements lease being or having been performed by processing

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data in a non-transitory memory of a computer”. Claim 181 recites the limitation “hardware and software designed to assist a tenant in entering an improvements lease”. Firstly, it is not clear as to what are the metes and bounds of “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer”, “at least some portion of the improvements lease being or having been performed by processing data in a non-transitory memory of a computer”, “at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer”. Secondly it is not clear as to what specific aspect of the lease is performed by processing data in a non-transitory memory of a computer. The metes and bounds of these limitations are unclear. In view of these reasons the scope of the claim is unclear. Similar reasoning applies for claims 148, and 180. Similarly in claim 181 it is not clear what kind of assistance is provided to the tenant by the hardware and software. Also it is not clear what the term “assist a tenant” entails. The metes and bounds of this limitation are unclear. Appropriate correction is required. The dependent claims are rejected for the same reasons and also by way of dependency on a rejected independent claim.

Claims 28, 35, 57, 95, 114, 120, 122, 143, 170, 175, 179-205 recite the limitation “a true lease under tax accounting rules”. It is not clear what the Applicant means by the term “true lease”.

The rejections below are interpreted in light of 35 USC 112, second paragraph rejections above.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 1-27, 31-52, 56-180, and 183-205 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

Claims 1-27, 31-52, 56-180, and 183-205 are rejected under 35 USC 101 because they are drawn to an abstract idea.

Based upon consideration of all of the relevant factors with respect to the claims as a whole, claims 1-27, 31-52, 56-180, and 183-205 are held to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C. § 101. The rationale for this finding is explained below:

- Insufficient recitation of a machine or transformation.
- The computer is generically recited such that it covers any computer capable of performing the claimed step(s). There is nothing in the specification to suggest that the computer is a particular machine.
- The computer is merely an object on which the method operates.

Hence the method of claim 1 does not qualify as a process under 35 USC 101. Claims 2-8 are rejected by way of dependency on a rejected claim.

Another possible identifying characteristic an abstract idea is if the claim is so broad that it covers (preempts) any and every possible way that the steps can be performed, because there is no “practical application” if no specific way is claimed to perform the steps. (*See p.21 of Ex-Parte Bilski et al. Appeal No. 2002-2257*). Pre-emption means a claim covers “any and every” possible way that the process is performed. For instance the independent claims recite the limitations “at least some portion of the improvements lease is being or having been performed

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by processing data in a non-transitory memory of a computer” or “at least some portion of the lease being or having been performed by processing data in a non-transitory memory of a computer” or “at least some portion of leasing the shorter-lived asset being or having been performed by processing data in a non-transitory memory of a computer” or “at least some portion of soliciting, originating, managing, or analyzing the improvements lease being or having been performed by processing data in a non-transitory memory of a computer”. It is also not definite because it fails to particularly point out how a certain process is carried out. When a method can be performed by a human and also by a computer or a specific result can be obtained in many possible ways the claim pre-empts all possible ways of determining the result. In the instant case, the method can be performed by a human and also by a computer. Also the ambiguities identified in the 35 USC 112, second paragraph rejections above indicates that the specific results of implementing the claimed methods can be obtained in many possible ways. Hence the claimed inventions pre-empt all possible ways of determining the result. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 28-30, 53-55 and 181-203 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weatherly et al. (US Patent 6,049,784).

Claim 28, Weatherly discloses a computer programmed to solicit proposals from tenants for financing for tenant improvements to spaces leased by the respective tenants under respective space leases; and to solicit offers of financing from lenders to the tenants' proposals, and notify the respective tenant and lender when an offer matches a proposal (See the entire disclosure of Weatherly particularly Column 1 lines 9-58, Column 3 lines 45-52, Column 3 line 66 – Column 4 line 65, Column 5 line 60 – Column 7 line 67 and Column 8 lines 1-12). Weatherly does not explicitly disclose the features of each proposal offering terms for lease of tenant improvements to the corresponding space under an improvements lease distinct from the corresponding space lease, each improvements lease to be structured together with the corresponding space lease to support an accounting conclusion that the space lease and improvements lease are to be considered together as a single lease and classified as an operating lease. However these features are interpreted as non-functional descriptive material as they do not materially affect the steps of soliciting proposals, soliciting offers of financing and notifying the respective parties when an offer matches a proposal.

Claim 53, Weatherly discloses a computer programmed to solicit proposals from tenants for financing for tenant improvements to spaces leased by the respective tenants under respective space leases; and to solicit offers of financing from lenders to the tenants' proposals, and notify the respective tenant and lender when an offer matches a proposal (See the entire disclosure of Weatherly particularly Column 1 lines 9-58, Column 3 lines 45-52, Column 3 line 66 – Column 4 line 65, Column 5 line 60 – Column 7 line 67 and Column 8 lines 1-12). Weatherly does not

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explicitly disclose the features of each proposal offering terms for lease of tenant improvements to the corresponding space under an improvements lease distinct from the corresponding space lease, each improvements lease providing for lease of tenant improvements from a special purpose entity to the tenant, a landlord of the space being the owner of, or lessor of the tenant improvements to, the special purpose entity under tax accounting rules, financial statements of the special purpose entity to be consolidated with financial statements of the landlord, rent payments under the improvements lease to be fully tax deductible to the tenant. However these features are interpreted as non-functional descriptive material as they do not materially affect the steps of soliciting proposals, soliciting offers of financing and notifying the respective parties when an offer matches a proposal.

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. In this claim there is no new and unobvious functional relationship between the descriptive material and the substrate.

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Claims 29 and 54, Weatherly does not explicitly disclose the feature of the computer being further programmed to solicit offers of financing using an auction protocol. However Official notice is taken that soliciting offers of financing using an auction protocol is old and well known in the art. The motivation to combine this feature is that it helps in facilitating numerous offers from several participants interested in making the offers.

Claims 30 and 55, Weatherly teaches the features of the computer being further programmed to store information on a plurality of loans between tenants and landlords, and to analyze the information (See the entire disclosure of Weatherly particularly Column 5 line 60 – Column 6 line 60). Weatherly does not explicitly disclose the feature wherein the loan is a tenant improvement loan closed between tenant and landlord. However this feature is interpreted as as non-functional descriptive material as they do not materially affect the steps of storing information and analyzing the information. As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claim 181, Weatherly discloses a computer system, comprising: hardware and software designed to assist a tenant in entering a lease (See the entire disclosure of Weatherly particularly Column 4 lines 12-30, Column 5 line 60 – Column 6 line 60, claims 15 and 29); and non-transitory memories storing data (See the entire disclosure of Weatherly particularly Column 4 lines 12-30, Column 5 line 60 – Column 6 line 60, claims 15 and 29). Weatherly does not explicitly teach the features where the lease is an improvements lease, the improvements lease to grant the tenant possession and use of improvements to a space leased to the tenant under a space lease that is distinct from the improvements lease; data providing that the space lease and improvements lease are to be consolidated together as a single lease for financial accounting; and

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data providing that, for financial accounting, the consolidated lease is to be treated as an operating lease under financial accounting rules or a true lease under tax accounting rules. However these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored respectively. The non-functional descriptive data does not materially affect the features of entering a lease and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claim 182, Weatherly discloses one or more non-transitory memories, having stored thereon computer programs and/or data to cause at least one computers to: process a payment on a lease (See the entire disclosure of Weatherly particularly Column 4 lines 12-30 and claims 15 and 29). Weatherly does not explicitly teach the features of a lease for improvements to a space, financing for the improvements being provided by an entity other than a tenant of the space, financing for the improvements being obtained at the tenant's cost of funds, the space being leased from a landlord to the tenant under a space lease, the improvements lease being distinct from the space lease, at least some portion of the programs and/or data reflecting a characteristic of the improvements lease or the interrelationship between the space and improvements leases. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional

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relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claim 183, Weatherly discloses a method comprising the steps of: processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease (See the entire disclosure of Weatherly particularly Column 4 lines 12-30 and claims 15 and 29). Weatherly does not explicitly teach the features of a lease granting rights to use tenant improvements to a tenant, the tenant improvements being improvements to a space leased to the tenant, financing or ownership of the tenant improvements being distinct from financing or ownership of the space, an amount of the payment payable to a tenant improvements payee for lease of the tenant improvements being segregable from an amount payable to a distinct space payee for lease of the space, the segregation reflecting the distinct ownership or financing, the lease of the improvements and the lease of the space lease being structured to support an accounting conclusion that the leasing of the space lease and the leasing of the tenant improvements are to be considered together as a single lease and classified as an operating lease under financial accounting rules or a true lease under tax accounting rules; the processed data representing at least one of a group consisting of (a) the lessor of the space, (b) the lessor of the tenant improvements, (c) the tenant, and (d) a primary investor, secondary investor, or lender, who contributed capital to the improvements or to an entity owing the improvements. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not

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materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claims 184-192, the limitations in these claims are interpreted as non-functional descriptive data that describe the underlying contract, the payment being processed and the data being stored. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claim 193, Weatherly discloses a method comprising the steps of: processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease (See the entire disclosure of Weatherly particularly Column 4 lines 12-30 and claims 15 and 29). Weatherly does not explicitly teach the features of a lease granting rights to use a shorter-lived asset to a lessee, the shorter-lived asset being functionally related to a longer-lived asset also leased to the lessee, financing or ownership of the shorter-lived asset being distinct

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from financing or ownership of the longer-lived asset, an amount of the payment payable by the lessee to a payee for the Shorter-lived asset for lease of the shorter-lived asset being segregable from an amount payable by the lessee to a distinct payee for lease of the longer-lived asset, the segregation reflecting the distinct ownership or financing, the segregable payment stream directed to the shorter-lived asset having a present value at least equal to a cost of the shorter-lived asset at a time of commencement of the lease covering the shorter-lived asset; at least some portion of the lease to the shorter-lived asset being structured together with the lease to the longer-lived asset to support an accounting conclusion that the two leases are to be considered together as a single lease, classified as an operating lease under financial accounting rules or a true lease under tax accounting rules. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claims 194-196, the limitations in these claims are interpreted as non-functional descriptive data that describe the underlying contract, the payment being processed and the data being stored. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner

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need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claim 197, Weatherly discloses a method comprising the steps of: processing data in a non-transitory memory of a computer, the processing reflecting paying or receiving a payment on a lease (See the entire disclosure of Weatherly particularly Column 4 lines 12-30 and claims 15 and 29). Weatherly does not explicitly teach the features of a lease granting rights to use tenant improvements to a tenant, the tenant improvements being improvements to a space leased to the tenant, financing or ownership of the tenant improvements being distinct from financing or ownership of the space, an amount of the payment payable to a tenant improvements payee for lease of the tenant improvements being segregable from an amount payable to a distinct space payee for lease of the space, the segregation reflecting the distinct ownership or financing; financing for the tenant improvements being provided by an entity other than a tenant of the space, financing for the tenant improvements being obtained at the tenant's cost of funds; the processed data representing at least one of a group consisting of (a) the lessor of the space, (b) the lessor of the tenant improvements, (c) the tenant, and (d) a primary investor, secondary investor, or lender, who contributed capital to the improvements or to an entity owing the improvements. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner

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need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Claims 198-203, the limitations in these claims are interpreted as non-functional descriptive data that describe the underlying contract, the payment being processed and the data being stored. As discussed above these are interpreted as non-functional descriptive data that describe the underlying contract and the data being stored. The non-functional descriptive data does not materially affect the features of processing the payment and storing data. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). As discussed above there is no new and unobvious functional relationship between the descriptive material and the substrate.

Response to Arguments

14. Applicant's arguments with respect to pending claims have been considered but are moot in view of new grounds of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the enclosed PTO-892.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3691

May 22, 2011